

REMARKS

Claims 1-18 and 21 are pending in this application. Claims 1- 6, 9-15, and 21 have been amended. Support for the amendments to the claims may be found in the claims as originally filed, and at page 8, line 24, page 13, lines 1, 2, and 3, page 19, lines 10 and 11, and page 24, lines 5-8 of the specification. Since the amendments to the claims are being made at the behest of the Examiner, this amendment is believed to place the application in condition for allowance, and entry therefore is respectfully requested. In the alternative, entry of this amendment is requested as placing the application in better condition for appeal by, at least, reducing the number of issues outstanding. Further reconsideration is requested based on the foregoing amendment and the following remarks.

Finality of the Office Action:

The Applicants acknowledge with appreciation the withdrawal of the finality of the Office Action mailed July 14, 2005. The Applicants submit, however, that the subject Office Action should not have been made final, either, since new grounds of rejection are being presented, and no claims were amended in the response filed November 1, 2005. The Applicants have thus had no chance to respond to the new grounds of rejection included in the subject final Office Action. Withdrawal of the finality of the subject Office Action is therefore requested respectfully as well.

Response to Arguments:

The Applicants appreciate the consideration given to their arguments. The Applicants, however, are disappointed that their arguments were not found to be persuasive. Further reconsideration is thus requested.

Claim Rejections - 35 U.S.C. § 112:

Claims 1-18 and 21 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

The final Office Action appears to be looking for literal support for the language used in the claims in the specification. To the contrary, the disclosure as originally filed does not have to provide verbatim support for the claimed subject matter at issue in order to satisfy the written description requirement. See Fujikawa v. Wattanasin, 93 F.3d 1559, 1570, 39 USPQ2d 1895, 1904 (Fed. Cir. 1996). Instead, "the written description requirement is satisfied by the patentee's disclosure of 'such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention.'" Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

Put another way, one skilled in the art, reading the original disclosure, must reasonably discern the limitation at issue in the claims. Waldemar Link GmbH & Co. v. Osteonics Corp., 32 F.3d 556, 558, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994). As quoted in MPEP § 2163, in Vas Cath Inc. v. Mahurkar, 935 F.2d 1555, 1561, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991), the Federal Circuit held that “under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by § 112.” 935 F.2d at 1565, 19 USPQ2d at 1118.

Drawings constitute an adequate description if they describe what is claimed and convey to those of skill in the art that the patentee actually invented what is claimed. *Id.* at 1566, 19 USPQ2d at 1119. In Vas-Cath, the Federal Circuit reversed the district court’s grant of summary judgment of invalidity of claims to a double lumen catheter having a combination of features. Specifically, the Vas-Cath court determined that drawings alone of a double lumen catheter from a parent design patent application provided sufficient written description to support claims directed to a catheter having a “return lumen diameter substantially less than 1.0 but substantially greater than 0.5 times the diameter of the combined lumens.” *Id.* at 1566, 19 USPQ2d at 1119. In doing so, the court stated, “[c]onsideration of what the drawings conveyed to persons of ordinary skill in the art is essential.” *Id.* The court concluded that the drawings conveyed with reasonable clarity to those of ordinary skill in the art that the patentee had invented the catheter recited in the claims.

Still, in the interest of compact prosecution, and not for any reason of patentability, the offending passages have been removed. Support for the amendments to the claims may be found in the claims as originally filed, and at page 8, line 24 (movable goods), page 13, lines 1, 2, and 3 (customers A and B), page 19 lines 10 and 11 (execution, executing), and page 24, lines 5-8 (chain order processing) of the specification. Claims 1-18 and 21 are thus submitted to meet the requirements of 35 U.S.C. § 112, first paragraph. Withdrawal of the rejection is earnestly solicited.

Claim Rejections - 35 U.S.C. § 103:

Claims 1, 3, 5, 7-10, 12, 14, 16, 17, 18 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,787,402 to Potter et al. (hereinafter “Potter”) in view of Dian Hymer, “Starting Out The Complete Home Buyer’s Guide,” Chronicle Books, San Francisco, 1997 (hereinafter “Hymer”). The rejection is traversed to the extent it might apply to the claims as amended. Further reconsideration is earnestly solicited.

Claim 1 recites:

A chain order, the chain order being an order requesting, on condition of sale or purchase of first movable goods by customer A, purchase or sale of second movable goods different from the first movable goods by customer B.

Potter neither teaches, discloses, or suggests a chain order, contrary to the assertion in the final Office Action at page 4. Potter, rather, at most, allows a *single* client to link several of his or her *own* orders together. In particular, as described in Potter at column 14, lines 54-63:

FX Order Strategies allow orders to be linked to other orders under certain conditions. The Order Blotter indicates orders' Strategies, if any. This includes: allowing an Active order to be set to another order to Cancel if the Active order is Done (OCO); setting an Active order to execute only if another designated Active order executes (IF/THEN); selecting orders for placement in loops so that orders effect each other in different ways depending on each selected order's individual state (LOOP); and selecting a group of orders and assigning specific states to each order (OCORE).

Claim 1, in contrast, recites a "chain order," in which, in particular, "on condition of sale or purchase of first movable goods by customer A, purchase or sale of second movable goods different from the first movable goods by customer B."

Claim 1 recites further:

A chain order processing unit responsive to the detection of a buy or sell order with respect to a predetermined chain order by said order detecting unit, for performing a selling or purchasing process with respect to the first movable goods by said customer A and performing a purchasing or selling process with respect to the second movable goods by said customer B.

Potter neither teaches, discloses, or suggests a chain order, as discussed above, let alone "performing a selling or purchasing process with respect to the first movable goods by said customer A and performing a purchasing or selling process with respect to the second movable goods by said customer B."

Potter, furthermore, teaches away from chain orders by warning that the customer must not be permitted to purposefully postpone commitment to an offer until after the market has moved and then, if the movement is to the customer's advantage, accept the offer. This is exactly what a contingent sale, such as a chain order, attempts to do: purposefully postpone commitment to an offer until after the market has moved, i.e. the contingent sale has taken place. In particular, as described in Potter at column 2, lines 59-64:

In a similar vein, whatever system is used must require that the customer commit quickly to the bank's offer. The customer must not be permitted to purposefully postpone commitment to an offer until after the market has moved and then, if the movement is to the customer's advantage, accept the offer.

It is submitted, therefore, that persons of ordinary skill in the art would not have been motivated to modify Potter to arrive at the claimed invention, because Potter warns against permitting a customer to purposefully postpone commitment to an offer until after the market has moved.

Finally, even if Potter could be modified to arrive at the claimed invention, Hymer could not supply the difference, since Hymer, as a piece of literature, would not have been enabling. In particular, to serve as an anticipating reference, Hymer must enable that which it is asserted to anticipate.

"A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled." Amgen, Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003). See Bristol-Myers Squibb v. Ben Venue Laboratories, Inc., 246 F.3d 1368, 1374, 58 USPQ2d 1508, 1512 (Fed. Cir. 2001) ("To anticipate the reference must also enable one of skill in the art to make and use the claimed invention."); PPG Industries, Inc. v. Guardian Industries Corp., 75 F.3d 1558, 1566, 37 USPQ2d 1618, 1624 (Fed. Cir. 1996) ("To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter."). Elan Pharmaceuticals Inc. v. Mayo Foundation for Medical Education and Research, 68 USPQ2d 1373 (CAFC 2003).

Since Hymer merely mentions contingent offers, but does not teach persons of skill in the art how to provide "a chain order processing unit responsive to the detection of a buy or sell order with respect to a predetermined chain order by said order detecting unit, for performing a selling or purchasing process with respect to the first movable goods by said customer A and performing a purchasing or selling process with respect to the second movable goods by said customer B," as recited in claim 1, Hymer cannot be enabling within the provisions of 35 U.S.C. § 112, first paragraph. Since Hymer cannot enable chain orders, Hymer cannot anticipate chain orders. Thus, Hymer shows no chain order either, and so even if Potter and Hymer were combined as proposed in the final Office Action, the claimed invention would not result.

Finally, M.P.E.P. § 2143.01 prohibits a proposed modification that renders a reference unsatisfactory for its intended purpose. The purpose of Potter is to perform automated financial transactions involving at least two currencies at real-time market rates between a customer and a financial institution. There is no place for chain orders in transactions involving only a customer and a financial institution, since there is no second customer upon whose purchase or sale the first customer's activities might be made to depend. In particular, as described in Potter at column 1, lines 9-14:

The present invention relates generally to methods and systems for performing automated financial transactions, and more particularly to a method and system for performing automated financial transactions involving at least two currencies at real-time market rates between a customer and a financial institution.

Since there is no place for chain orders in transactions involving only a customer and a financial institution, which are the purpose of Potter to perform, it is submitted that persons of ordinary skill in the art at the time the invention was made would not have been motivated to

modify Potter as proposed by the final Office Action, since to do so would have rendered Potter unsatisfactory for its intended purpose. Claim 1 is submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claims 2, 3, 5, 7, and 8 depend from claim 1 and add additional distinguishing elements. Claims 2, 3, 5, 7, and 8 are thus also submitted to be allowable. Withdrawal of the rejection of claims 2, 3, 5, 7, and 8 is earnestly solicited.

Claim 9:

Claim 9 recites:

Permitting input of a chain order, the chain order being an order requesting, on condition of sale or purchase of first movable goods by customer A, purchase or sale of second movable goods different from the first movable goods by customer B.

Neither Potter nor Hymer teach, disclose, or suggest “permitting input of a chain order, the chain order being an order requesting, on condition of sale or purchase of first movable goods by customer A, purchase or sale of second movable goods different from the first movable goods by customer B,” as discussed above with respect to the rejection of claim 1.

Claim 9 recites further:

Responding to the detection of a buy or sell order with respect to a predetermined chain order by performing a selling or purchasing process with respect to the first movable goods by said customer A and performing a purchasing or selling process with respect to the second movable goods by said customer B.

Neither Potter nor Hymer teach, disclose, or suggest “responding to the detection of a buy or sell order with respect to a predetermined chain order by performing a selling or purchasing process with respect to the first movable goods by said customer A and performing a purchasing or selling process with respect to the second movable goods by said customer B,” as discussed above with respect to the rejection of claim 1, either. Thus, even if Potter and Hymer were combined as proposed in the final Office Action, the claimed invention would not result.

Furthermore, persons of ordinary skill in the art who read Potter for all it contained at the time the invention was made would have been deterred from modifying Potter as proposed in the final Office Action, as also discussed above with respect to the rejection of claim 1.

Finally, the modification of Potter proposed by the final Office Action renders Potter unsatisfactory for its intended purpose of performing automated financial transactions involving at least two currencies at real-time market rates between a customer and a financial institution, and ought to be withdrawn, as also discussed above with respect to the rejection of claim 1.

Claim 9 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 9 is earnestly solicited.

Claims 10, 11, 12, 14, 16, and 17:

Claim 10 recites:

Permitting input of a chain order, the chain order being an order requesting, on condition of sale or purchase of first movable goods by customer A, purchase or sale of second movable goods different from the first movable goods by customer B.

Neither Potter nor Hymer teach, disclose, or suggest "permitting input of a chain order, the chain order being an order requesting, on condition of sale or purchase of first movable goods by customer A, purchase or sale of second movable goods different from the first movable goods by customer B," as discussed above with respect to the rejection of claim 1.

Claim 10 recites further:

Responding to the detection of a buy or sell order with respect to a predetermined chain order by performing a selling or purchasing process with respect to the first movable goods by said customer A and performing a purchasing or selling process with respect to the second movable goods by said customer B.

Neither Potter nor Hymer teach, disclose, or suggest "responding to the detection of a buy or sell order with respect to a predetermined chain order by performing a selling or purchasing process with respect to the first movable goods by said customer A and performing a purchasing or selling process with respect to the second movable goods by said customer B," as discussed above with respect to the rejection of claim 1, either. Thus, even if Potter and Hymer were combined as proposed in the final Office Action, the claimed invention would not result.

Furthermore, persons of ordinary skill in the art who read Potter for all it contained at the time the invention was made would have been deterred from modifying Potter as proposed in the final Office Action, as also discussed above with respect to the rejection of claim 1.

Finally, the modification of Potter proposed by the final Office Action renders Potter unsatisfactory for its intended purpose of performing automated financial transactions involving at least two currencies at real-time market rates between a customer and a financial institution, and ought to be withdrawn, as also discussed above with respect to the rejection of claim 1. Claim 10 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 10 is earnestly solicited.

Claims 11, 12, 14, 16, and 17 depend from claim 10 and add additional distinguishing elements. Claims 11, 12, 14, 16, and 17 are thus also submitted to be allowable. Withdrawal of the rejection of claims 11, 12, 14, 16, and 17 is earnestly solicited.

Claim 18:

Claim 18 recites:

Permitting the input of a chain order, the chain order being an order requesting, on condition of execution of an order for sale of the first movable goods by customer A, purchase of a second movable goods by customer B from a third party, the second movable goods being different from the first movable goods.

Neither Potter nor Hymer teach, disclose, or suggest “permitting the input of a chain order, the chain order being an order requesting, on condition of execution of an order for sale of the first movable goods by customer A, purchase of a second movable goods by customer B from a third party, the second movable goods being different from the first movable goods,” as discussed above with respect to the rejection of claim 1.

Claim 18 recites further:

A chain order processor, responsive to the detection of said sell order for the first movable goods by said order detecting unit, automatically executing the chain order by purchasing the second movable goods by said customer B.

Neither Potter nor Hymer teach, disclose, or suggest “a chain order processor, responsive to the detection of said sell order for the first movable goods by said order detecting unit, automatically executing the chain order by purchasing the second movable goods by said customer B,” as discussed above with respect to the rejection of claim 1, either. Thus, even if Potter and Hymer were combined as proposed in the final Office Action, the claimed invention would not result.

Furthermore, persons of ordinary skill in the art who read Potter for all it contained at the time the invention was made would have been deterred from modifying Potter as proposed in the final Office Action, as also discussed above with respect to the rejection of claim 1.

Finally, the modification of Potter proposed by the final Office Action renders Potter unsatisfactory for its intended purpose of performing automated financial transactions involving at least two currencies at real-time market rates between a customer and a financial institution, and ought to be withdrawn, as also discussed above with respect to the rejection of claim 1. Claim 18 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 18 is earnestly solicited.

Claim 21:

Claim 21 recites,

permitting input of a chain order, the chain order being an order requesting, on condition of sale or purchase of first movable goods by customer A, purchase or

sale of second movable goods different from the first movable goods by customer B.

Neither Potter nor Hymer teach, disclose, or suggest “permitting input of a chain order, the chain order being an order requesting, on condition of sale or purchase of first movable goods by customer A, purchase or sale of second movable goods different from the first movable goods by customer B,” as discussed above with respect to the rejection of claim 1.

Claim 21 recites further:

Responding to the detection of a buy or sell order with respect to a predetermined chain order by performing a selling or purchasing process with respect to the first movable goods by said customer A and performing a purchasing or selling process with respect to the second movable goods by said customer B.

Neither Potter nor Hymer teach, disclose, or suggest “responding to the detection of a buy or sell order with respect to a predetermined chain order by performing a selling or purchasing process with respect to the first movable goods by said customer A and performing a purchasing or selling process with respect to the second movable goods by said customer B,” as discussed above with respect to the rejection of claim 1, either. Thus, even if Potter and Hymer were combined as proposed in the final Office Action, the claimed invention would not result.

Furthermore, persons of ordinary skill in the art who read Potter for all it contained at the time the invention was made would have been deterred from modifying Potter as proposed in the final Office Action, as also discussed above with respect to the rejection of claim 1.

Finally, the modification of Potter proposed by the final Office Action renders Potter unsatisfactory for its intended purpose of performing automated financial transactions involving at least two currencies at real-time market rates between a customer and a financial institution, and ought to be withdrawn, as also discussed above with respect to the rejection of claim 1. Claim 21 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 21 is earnestly solicited.

Claims 4, 6, 13, and 15:

Claims 4, 6, 13, and 15 were rejected under 35 U.S.C. § 103 as being unpatentable over Potter and Hymer, and further in view of Nymeyer, US 3,581,072 (hereinafter “Nymeyer”). The rejection is traversed. Reconsideration is earnestly solicited.

Claims 4, 6, 13, and 15 depend from claims 1 or 10 and add additional distinguishing elements. Neither Potter nor Hymer teach, disclose, or suggest a chain order, as discussed above with respect to the rejection of claim 1. Nymeyer does not either, and thus cannot make up for the deficiencies of either Potter or Hymer with respect to claims 4, 6, 13, and 15. Thus,

even if Potter Hymer, and Nymeyer were combined as proposed in the final Office Action, the claimed invention would not result.

Furthermore, persons of ordinary skill in the art who read Potter for all it contained at the time the invention was made would have been deterred from modifying Potter as proposed in the final Office Action, as also discussed above with respect to the rejection of claim 1.

Finally, the modification of Potter proposed by the final Office Action renders Potter unsatisfactory for its intended purpose of deferring adverse tax consequences and the creation of taxable events, and ought to be withdrawn, as also discussed above with respect to the rejection of claim 1. Claims 4, 6, 13, and 15 are submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claims 4, 6, 13, and 15 is earnestly solicited.

Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all of claims 1-18 and 21 are allowable over the cited references. The claims are therefore in a condition suitable for allowance. An early Notice of Allowance is requested.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

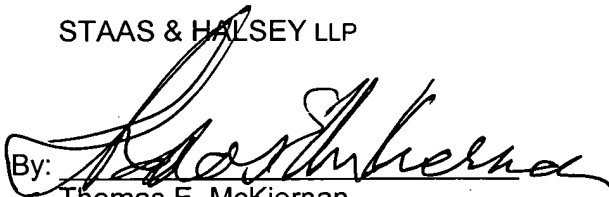
Respectfully submitted,

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